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Docket No.: SONY 3.0-027
(PATENT)

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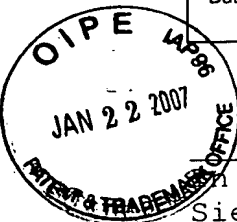
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Siegel et al.

Application No.: 09/726,973   Group Art Unit: 2152

Filed: November 30, 2000   Examiner: K. S. Lin

For: HOST SITE BASED INTERNET TRAFFIC
     METER

APPEAL REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA   22313-1450

Dear Sir:

Applicants file this reply brief in furtherance of the Applicants' appeal from the final rejection of claims 1-18 mailed August 19, 2005, and in response to the new arguments raised by the Examiner's Answer mailed December 4, 2006.

STATUS OF CLAIMS

Claims 1-18 remain pending and stand rejected.

A.   New Rejections under 35 U.S.C. § 112

In the Examiner's Answer, the Examiner newly raises a written description rejection under 35 U.S.C. § 112, first paragraph. The Examiner asserts that claims 1-18 are not described in the specification. The Examiner argues that the specification does not describe "modifying the content of the information presented to the user based upon the unique ID of the device used to access the host web site."

B. Rejection Under 35 U.S.C. § 103

In the Final Office Action mailed August 19, 2005, claims 1-18 were rejected as obvious. The obviousness rejections of independent claims 1 and 15 under 35 U.S.C. §103(a) are based on the combination of Mitchell (U.S. Published Application 2002/0013850) ("*Mitchell*") and Haitsuka (U.S. Patent No. 6,847,992) ("*Haitsuka*"). The dependent claims have also been rejected as obvious over *Mitchell* in view of *Haitsuka* and additional asserted prior art as identified in Applicants' previously filed Appeal Brief.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether the specification reasonably describes the feature of "modifying the content of the information presented to the user based upon the unique ID of the device used to access the host web site" to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

B. Whether *Haitsuka inherently* teaches clamed aspects of the invention that the Examiner admits to be missing from the primary reference (*Mitchell*) relating to: "assign[ing] a unique ID to each device among a plurality of devices used for presenting the personalized information; presenting content based upon also the unique ID of the device used to access the host web site and that the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices."

ARGUMENT

A. Applicants' written description satisfies 35 U.S.C. § 112, first paragraph with its discussion of the features of claims 1-18 including "modifying the content of the information

presented to the user based upon the unique ID of
the device used to access the host web site."

The Examiner has newly rejected claims 1-18 under 35 U.S.C.
§ 112, first paragraph. The Examiner argues that:

> None of the figures explicitly teach or suggest
> the use of unique ID of the devices used for accessing
> the host web site nor to modify contents of the
> information presented based on the unique ID. The
> specification also fails to present different
> information for each unique ID assigned to each device
> among the plurality of devices.

Examiner's Answer at 4-5. Applicants disagree. The
specification sufficiently describes these features in
accordance with 35 U.S.C. § 112, first paragraph.

The Court of Appeals for the Federal Circuit has frequently
addressed the "written description" requirement of §112. *Vas-
Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). A
uniform standard for determining compliance with the "written
description" requirement has been maintained as follows:
"Although [the applicant] does not have to describe exactly the
subject matter claimed, ... the description must clearly allow
persons of ordinary skill in the art to recognize that [he or
she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008,
1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (citations omitted).
"[T]he test for sufficiency of support in a parent application
is whether the disclosure of the application relied upon
'reasonably conveys to the artisan that the inventor had
possession at that time of the later claimed subject matter.'"
Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227
USPQ 177, 179 (Fed. Cir. 1985) (*quoting In re Kaslow*, 707 F.2d
1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Applying this standard to the claimed invention, it is
clear that the specification satisfies the written description
test, including the features at issue in the Examiner's

rejection. For example, paragraphs 7-11 of the summary section of the specification describe that a particular cookie that includes unique personal information constitutes a unique identity that is used to customize the web experience of a user. Thus, the specification recites:

> At the host web site, the user will be queried as to whether he or she wishes to complete a personal data registration form so as to register with the host web site. ... The user's activities are tracked so that the host web site may gather information about the user's interests and preferences. As a result, when the user returns to the host web site at a future date, the content of the information displayed to the user will be modified so that the content of the information substantially matches the user's interests and/or personal demographic data...
>
> If the user does complete the personal data registration form, then the host web site will transmit a cookie to the user's hardware. The cookie may be stored in the user's hard drive. The user will then complete the personal data registration form that preferably includes information such as the user's name, address, zip code, telephone number, e-mail address, age and occupation. As the user completes the personal data registration form, the personal data will be recorded on the user's cookie. The data recorded on the cookie will be transmitted to the host web site. The cookie information including the personal data is preferably recorded in one or more databases maintained by the host web site so that the information can be retrieved and updated each time a user access the host web site. Upon receiving the personal data, the host web site will process the information and store it in a database. In certain preferred embodiments, each user may be indexed by one or more components of the personal data (e.g. by last name or social security number).
>
> In certain preferred embodiments, a user may be assigned a unique identity that is linked to the personal computer (PC) used to access the host web site. For example, a user may visit business related web sites from a first PC at work and entertainment related sites from a second PC at home. The host web site of the present invention desirably assigns a first cookie to the user's work PC and a second cookie

to the user's home PC. The cookie assigned to the work PC will track and monitor the web sites that the user visits at work. This information will be stored in a database maintained by the server of the host web site. The cookie assigned to the home PC will track and monitor the web sites that the user visits at home. This information will also be stored by the server of the host web site. The information stored about usage of the work PC will have a different content than the information stored on usage of the home PC. As a result, the user's experience when visiting the host web site may be very different depending upon which PC is utilized to visit the host web site.

By completing the personal data registration form, the user agrees that his subsequent web surfing activities may be monitored, recorded and stored on the user's cookie. ...

When the user returns to the host web site, the host web site will retrieve information from the user's cookie so as to identify the identity of the user. The host web site will then compare the information retrieved from the cookie with any information previously stored at the host web site. The host web site will then update its profile for the user, if necessary, including any subsequent web surfing activities recorded on the user's cookie.

Specification at ¶¶ 7-11 (emphasis added).

Figure 2 similarly illustrates the use of entered personal data about a user in a cookie of a particular computer to personalize a web site visited by the user of that computer. Example information in the cookie embodiment for establishing a unique identity is further described in the detailed description portion of the specification. See, e.g., specification at ¶ 22-23 (reciting user's name, address, zip code, phone number, email address, age, occupation, social security number, taxpayer identification number).

In short, the specification provides a clear description with examples of the claimed invention that reasonably conveys to the artisan that the inventor had possession at the time of filing the application. Accordingly,

Applicants request that the Board reverse the Examiner's rejection under 35 U.S.C. § 112, first paragraph.

> B.   The applied references of *Mitchell* and *Haitsuka* do not render Applicants' invention obvious in view of at least the features of claims 1-18 including:
>   assigning a unique ID to each device among a plurality of devices used for presenting the personalized information and modifying the content of the information presented to the user based upon the unique ID of the device used to access the host web site, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

In maintaining the position of the obviousness of the independent claims based on the combination of *Mitchell* and *Haitsuka*, the Examiner still concedes that:

> Mitchell did not specifically teach to assign a unique ID to each device among a plurality of devices used for presenting the personalized information; presenting content based upon also the unique ID of the device used to access the host web site and that the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

Examiner Answer p. 6, ¶ 6. However, he argues that *Haitsuka*

> taught to assign a unique ID (e.g. cookie) to each device among a plurality of devices use for presenting the personalized information... cookie is inherently known to contain user or device identification: a cookie is information that web server puts on a user's hard disk so that the web server can remember something about the user at a later time. (e.g. identifying a user) and to present the content information based upon the unique ID of the device (e.g. assigned cookie)...

Examiner Answer p. 6, ¶ 6 (emphasis added). Moreover, apparently relying on the disclosure of Applicants' specification, the Examiner contends that what Applicants' prior argument ignores is that the "cookie is the unique ID."

Examiner's Answer at 12-13 ("[T]he cookie is the unique ID as disclosed in the appellant's specification.")

Applicants submit that the Examiner is still reading more into *Haitsuka* than is actually disclosed in the applied reference and doing so in a manner that appears to constitute not only a misunderstanding of what the *Haitsuka* "cookie" is but also is an improper hindsight reliance on Applicants' own disclosure. Notwithstanding the Examiner's argument to the contrary, the aspects of Applicants' invention admittedly missing from *Mitchell* are not inherent in *Haitsuka*.

As the relied-on *Haitsuka* reference explains, assigning a cookie to a device is not inherently assigning a unique ID to each device among a plurality of devices as claimed by Applicants. It is merely a way in which information may be stored on a client computer with a web server. In other words, the information stored in the *Haitsuka* cookie is not necessarily a unique identification among a plurality of devices as used in the context of Applicants' claims. For example, *Haitsuka* explains that:

> A cookie is a mechanism that allows the server to
> store its own information about a user on the user's
> own computer... Cookies can be used by a web server
> to customize pages <u>for a user's browser type</u>...

Haitsuka, col. 3, lines 14. Thus, *Haitsuka* describes that a cookie may be used for identifying a browser type (*i.e.*, "Internet Explorer 4.0"). This would clearly not constitute a unique ID because that type of browser is used by many devices.

Thus, by this example described by *Haitsuka*, a cookie is not inherently a unique identification of a device in a plurality of devices because it does <u>not necessarily</u> contain such unique information. The Examiner simply has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic

necessarily flows from the teachings of the applied prior art. MPEP § 2112 at 2100-48 (quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). The fact that a certain result or characteristic might occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

The Examiner has also improperly attempted to support the inaccurate inherency interpretation of Haitsuka with statements in Pogue (U.S. Patent no. 6,112,240), a non-cited reference that was only first mentioned in an advisory action. However, the Examiner is not relying on Pogue in the obviousness rejection itself and there is no relationship between the systems of Pogue that would suggest that it is describing what was intended by Haitsuka. Moreover, even if Pogue says what is argued, it would be inconsistent with the express statements of the relied on Haitsuka reference which, as discussed above, discloses that a cookie is not inherently what Applicants have claimed as it may simply contain something that is not unique to one device in a group of devices (i.e., the type of browser). In other words, Pogue should not be used to recast what was said in Haitsuka.

Nevertheless, what Pogue actually says does not in and of itself demonstrate that a cookie must necessarily be an assigned unique ID to each device among a plurality of devices used for presenting personalized information. In fact, the statement in Pogue relied upon by the Examiner actually teaches that it is not necessarily what the Examiner contends. Pogue states as follows:

> The cookie may include a unique identification number identifying the client computer 200 and/or the last web page in the web site 306 that was visited visited by such browser 302.

Pogue, col. 7, lines 4-7 (emphasis added). In view of the use of the above underlined text, it is clear that the *Pogue* cookie does not necessarily include a unique identification as it "may" do so. It does not say "must." Moreover, since a unique identification is disclosed as a possible <u>alternative</u> to using just the last web page ("and/<u>or</u>") it is clear that the *Pogue* cookie contemplates using the last web page visited without the unique identification. In short, *Pogue's* cookies as relied upon by the Examiner do not demonstrate that *Haitsuka's* cookies necessarily assign a unique ID to each device among a plurality of devices used for presenting personalized information in the context the Applicants' invention.

For at least these reasons, *Haitsuka* does not inherently disclose Applicants' invention and, it does not make up what by the Examiner's admission is not disclose in *Mitchell*, to wit, Applicants' invention including:

<u>assigning a unique ID to each device among a plurality of devices used for presenting the personalized information;</u>
using the host web site for obtaining personal data about a user during a visit to the host web site;
after the host web site obtains the personal data about the user, using the host web site for monitoring the content of information viewed by the user while the user visits other web sites; and
during a subsequent visit by the user to the host web site, personalizing the information presented to the user, <u>wherein the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the personal data obtained about the user and the content of the other web sites visited by the user, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.</u>

Accordingly, Applicants request that the Board reverse the Examiner's obviousness rejection since the invention is not obvious over the cited combination of *Mitchell* and *Haitsuka*.
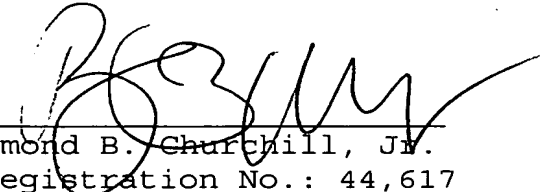
CONCLUSION

Applicants submit that claims 1-18 satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. Moreover, Applicants respectfully submits that claims 1 and 15 are not obvious in view of the applied combination of *Mitchell* and *Haitsuka*. Similarly, claims 2-14 and 16-18 which depend from one of claims 1 and 15 are not obvious at least due to such dependency in that they contain the unique and non-obvious subject matter of the independent claims that is not disclosed in the prior art.

Accordingly, it is respectfully submitted that the Examiner erred in rejecting claims 1-18 and a reversal of such rejections by this Honorable Board is solicited.

Dated: January 18, 2007   Respectfully submitted,

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